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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,200	05/14/2001	Cindy L. Price	659-787	8178

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EXAMINER
REICHLE, KARIN M

ART UNIT	PAPER NUMBER
3761	

DATE MAILED: 04/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/855,200	PRICE ET AL.	
	Examiner	Art Unit	
	Karin M. Reichle	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 October 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) *See Continuation Sheet* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,5,8-11,14,16,17,20-22,24-27,30-32,34,35,40,41 and 44-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 May 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4781012* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3,6,7,12,13,15,18,19,23,28,29,33,36-39,42,43 and 46.

1. Applicant's election without traverse of the species of Figures 5-8 in Paper No. 11 is acknowledged.

2. Claims 3, 6-7, 12-13, 15, 18-19, 23, 28-29, 33, 36-39, 42-43, 46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 11

The election of species set forth in Paper No. 9 is deemed proper and made FINAL.

3.. It is noted that the Examiner agrees that claims 5, 14, 17, 21 and 27 are also generic but does not agree that claim 2 is generic due to lines 4-5 thereof.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For example:

5. The abstract of the disclosure is objected to because legal terminology, i.e. "comprises", "comprising", and terminology which can be inferred, i.e. "also is provided" should be avoided. Correction is required. See MPEP § 608.01(b).

6. The use of the trademark VELCRO and HUGGIES has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be shown either by capitalizing all the letters thereof or providing the symbol.

7. The incorporation of essential material in the specification by reference to a foreign application or patent, to a publication, or to a US Patent or US Patent Application which itself incorporates such material is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). The incorporations in the instant application should be reviewed to ensure their propriety.

8. The prior art cited in the specification has been noted but will not appear on the front of a patent, if any, unless cited on a PTO-892 or -1449 which accompanies this action, since such citations do not comply with 37 CFR 1.56, 1.97 and 1.98.

9. The drawings are objected to because Figures 1, 5, 9, 13, 17, 21 and 25 are inconsistent with the descriptions thereof on pages 3-4, i.e. Figures are partially cut away but not described as such. In Figure 1, the line from 10 should not be dashed. The lines denoting edges 14 and 16 as well as the lines from the numerals thereto should be dashed to denote underlying structure. This also applies to elastics 36 and the line from the numeral 36. The line from the leftmost 26 and 30

does not denote the correct structure, i.e appears to denote elastics 38. On the rightmost fastener 42, the attachers 43 should be dashed to denote underlying structure. A line from each numeral 80-86 should be provided and those from 82 and 86 should be dashed. These comments also apply to Figures 5, 9, 13, 17, 21 25 to similar depictions. In Figure 2, a cross section of Figure 1, elements 88 and 90 should not be shown. The line from 74 should extend all the way to the core side. In Figure 3, again 88 and 90 should not be shown. Also the rightmost 80 should have a line to the margin not an arrow. In Figure 4, the lines from 43 and 28 should extend all the way to the structure it denotes. These comments also apply to Figures 6-8, 10-12, 14-16, 18-20, 22-24, and 26-28 to similar depictions. In Figure 5, the line from the rightmost 32 does not denote the correct structure, i.e. appears to denote elastic 36. In Figure 2 the line from the left 80 and in Figure 3, the line from 90 does not denote the right structure. In Figure 9, the line from the right 43 should also be dashed. In Figure 13, the line from 98 does not denote the right structure and the line from 64 should not be dashed. In Figure 17, 88 should be 58. Also the left 32 and right lower 36 do not denote the correct structure. In Figure 20, 44 should be 43. Also, Figure 19 does not show a reduction in the side margins from that show in Figure 18 as set forth in Figure 17. In Figure 21, the line from 114 should not be dashed. The line from 118 does not denote the edge as described. In Figure 22, the line from 72 does not extend to the surge layer. In Figure 24, 170 should be 172. In Figure 25, the line from the left 45 does not lead to the connection. Also the numerals (82, 84), 302 and 306 do not denote the proper structure. A proposed drawing

correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

10. The disclosure is objected to because of the following informalities: on page 4, line 23, "sixth" should be --seventh--. What is 12 in Figures 3-4? 100 in Figure 15? 110 in Figures 23-24? On page 19, line 28, "84, 86" should be --80, 82--.

Appropriate correction is required.

11. Claims 2, 4-5, 8-11, 14, 16-17, 20-22, 24-27, 30-32, 34-35, 40-41 and 44-45 are objected to because of the following informalities: in each of these claims, line 1, if the term "invention" is present it should be --garment-- or --method-- as appropriate. In claim 14, line 2 "a" should be deleted and "panel" should be --panels-- and after "each", --panel-- should be inserted. In claim 21, line 3, after "portion", --, respectively-- should be inserted. In claim 22, after "margins", insert --each--. In claims 40-41, line 1, "said" should be --each--. The comments with respect to claims 21, 22, 40 and 41 also apply to claims 31-32 and 44-45. In claim 24, line 9, after "and" --each margin-- should be inserted. In claim 30, "margin is' should be --margins are--. Appropriate correction is required.

12. Claims 2, 11, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, are the first and second locations in this claim and the location in claim 1 one and the same, i.e. how many locations at a minimum are being claimed? In claim 11 are the side

margins in this claim and the margin in claim 1 one and the same, i.e. how may margins at a minimum are being claimed? In regard to claim 25, a positive structural antecedent basis for "said bodyside...margins" should be set forth.

13. In claim 14, last line "not attached" is interpreted as not being directly attached. This also applies to claim 24.

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-2, 4-5, 8-11, 14, 16-17, 20-22, 24-27, 30-32, 34-35, 40-41 and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Buell '115.

See Figures 1-2, Figure 7, Figure 9, Figure 9a, Figure 10, Figure 10a, Figure 11a, col. 3, lines 38-61, i.e. body panels are half belts 26 and 30, absorbent composite is body member 22 which includes a backsheet 41, a topsheet 40, a retention portion 42, the composite which is connected to the body surface of the half belts at longitudinally extending locations inwardly of proximal edges 71 and side margins are formed between edges 48 and 71 of both the topsheet and backsheet extending outward of the side edges of the core 42 and include an elastic element which extends less than the entire length of the composite. With regard to the method claims, see col. 3, lines 27-34 and col. 6, lines 24-50.

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 1-2, 4-5, 8-11, 14, 16-17, 20-22, 24-27, 30-32, 34-35, 40-41 and 44-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-5, 8-11, 13, 15-16, 19-21 of copending Application No. 10/053,251. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application was filed prior to '251 but there was no administrative delay, the one way In re Vogel test applies, i.e are the claims in the instant application obvious in view of the claims of the '251 application. The answer is yes. The claims

of the instant application are broader than the '251 claims. Once the Applicant has received a patent for a species or more specific embodiment Applicant is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other patents show various panels and side margins.

19. Any inquiry concerning this communication should be directed to K. M. Reichle at telephone number 703-308-2617. The Examiner's regular work schedule is Monday-Thursday. The Official RightFAX number is 703-872-9302.

K.M. Reichle

KMR

March 24, 2003